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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,102	04/13/2004	Jan Batzer	104035.277308	6148
7055 7590 09/12/2008 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER				
WEBB, WALTER E				
ART UNIT		PAPER NUMBER		
1612				
NOTIFICATION DATE		DELIVERY MODE		
09/12/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com

pto@gbpatent.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/824, 102

Applicant(s)

BATZER ET AL.

Examiner

WALTER E. WEBB

Art Unit

1612

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 July 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 2 and 5-11.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612

/Walter E Webb/
Examiner, Art Unit 1612

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's claimed invention remains obvious over the prior art. Applicant argues that the rejection does not explain why one of ordinary skill in the art would have an apparent reason to pick 8-hexadecene-1,16-dicarboxylic acid from the host of saturated, mono-unsaturated and di-unsaturated dioic acids which are encompassed by the general formula provided by Harding. However, it is the offices position that a prior art genus of many species suggests every species falling within that genus. It was explained previously that 8-hexadecene-1,16-dicarboxylic acid is encompassed by the formula of Harding and that the compounds of this formula are useful in compositions for topical application to the human skin. Applicant's invention is drawn to a dermatological composition. It would have been obvious at the time of applicant's invention to use a compound of the formula of Harding in a dermatological composition.

Applicant argues the method of making 8-hexadecene-1, 16-dicarboxylic acid is not disclosed in Harding. However, 8-hexadecene-1, 16-dicarboxylic acid is envisaged by Harding insofar as it meets the limitations of the formula I. Furthermore, applicant's invention is not drawn to a method of making 8-hexadecene-1, 16-dicarboxylic acid. Therefore, this argument is not commensurate with the claimed invention.

Applicant argues that since specific examples in Harding of dioic acids in composition are at least 15%, Harding teaches away from the subject matter of the claimed invention. However, Harding teaches use of its dioic acids at 0.1% which falls within the broad ranges of applicant's claim 9 of 0.001 to 10%, claim 10 of 0.05 to 8%, and claim 11 of 0.05 to 5%. A reasonable interpretation of the prior art includes more than specific examples.

Applicant argues that because the only example in Harding is butylated hydroxytoluene, the artisan would understand that antioxidants do not play any special role for the intended effect of the composition of Harding. However, Harding clearly stated that antioxidants form the balance of the composition. Nevertheless, the rejection of applicants invention in regard to antioxidants is not relied on by Harding alone. Schonrock, provides motivation for using antioxidants as well at a concentration range which closely meets the concentration range of claims 5-8.

Applicant argues that Shonrock does not provide any indication as to why it is an "advantage" to add customary antioxidants, and that this is indicative of conventional known advantages. However, the use of folic acid for its conventional advantages is sufficient motivation to add them to the composition Harding. Nevertheless, the fact that applicant has recognized another advantage from the addition of an antioxidant cannot be the basis for patentability. Also, these advantages upon which applicant relies are not recited in the rejected claims. Therefore, applicant's argument is not commensurate in scope with the claimed invention.

Applicant argues that there is no motivation to combine Harding and Schonrock since the compositions are entirely different. However, the compositions of Harding and Shonrock claim composition that are useful in lightening the skin, as per the instant claims. The motivation to combine their teachings stems from this commonality.